

REMARKS

The Applicant wishes to thank the Examiner for his examination of the present application. Claims 1, 12, 15-18 and 27 have been amended, and claims 28-46 have been added. Claim 2 has been cancelled without prejudice or disclaimer. Accordingly, claims 1 and 3-46 are pending in the case. No new matter has been added.

DRAWINGS

The Examiner objected to the drawings under 37 CFR 1.84(p)(5) as not including "the following reference sign(s) mentioned in the description: Figs. 8A-8C are missing from the drawings." Applicants respectfully point out that Figs. 8A-8C were originally filed with the application, and appear on page 18 of the figures, positioned beneath FIGs. 5L and 5M. As such, the objection is respectfully believed to be moot.

35 U.S.C. §102

Claims 1-3, 8, 9, 11, 17 and 19-27 were rejected under 35 U.S.C. §102(b) as anticipated by Fell et al. U.S. Patent Publication No. 2003/0055501 ("Fell '501"). The rejection is moot as to canceled claim 2. As to the other claims, Applicants respectfully traverse.

Applicants' claimed invention, as amended, features an implant for implantation on a femoral condyle. Claim 1 is exemplary, requiring such an implant having a bone-facing implant surface and an joint-facing implant surface; wherein the bone-facing implant surface opposes at least a portion of the femoral condyle and the trochlea, and the joint-facing implant surface opposes at least a portion of a tibial surface and a patella; and further wherein at least a portion of the bone-facing implant surface has a three-dimensional shape that

substantially matches the shape of at least a portion of an uncut articular surface that the bone-facing surface of the implant abuts.

Fell '501 does not anticipate the presently claimed invention. Fell '501 teaches an interpositional device, which, *inter alia*, is not for implantation on a femoral condyle, and does not have a bone-facing implant surface opposing at least a portion of the femoral condyle and the trochlea. Thus, since Fell '501 does not teach each and every feature of the claimed invention, the invention of claims 1-3, 8, 9, 11, 17 and 19-27 is novel and not anticipated. As such, withdrawal of the rejection is order and is respectfully requested.

35 U.S.C. §103

Claims 4 and 5 were rejected under 35 U.S.C. §103(a) as unpatentable (obvious) over Fell '501. The Examiner relied on Fell '501's discussion of multiple thickness devices in making the rejection. Claims 6, 7 and 10 were rejected under 35 U.S.C. §103(a) as unpatentable (obvious) over Fell '501 in view of Fell et al. U.S. Patent Publication No. 2003/0060882 ("Fell '882", also relating to an interpositional device.) The Examiner relied on Fell '882 allegedly teaching restoration of normal joint alignment without requiring any bone resection or means of bone fixation in making the rejection. Claims 12-14 were rejected under 35 U.S.C. §103(a) as unpatentable (obvious) over Fell '501 in view of Fell et al. U.S. Patent Publication No. 2003/0060884 ("Fell '884", also relating to an interpositional device.) The Examiner relied on Fell '882 allegedly teaching devices featuring various protrusions and relative orientations therefore, in making the rejection. Claim 15 was rejected under 35 U.S.C. §103(a) as unpatentable (obvious) over Fell '501 in view of Andriacchi et al. U.S. Patent Publication No. 2004/0098132 ("Andriacchi".) The Examiner relied on

Andriacchi allegedly teaching implants covering a portion of a patellar surface of the femur in making the rejection. Claim 16 was rejected under 35 U.S.C. §103(a) as unpatentable (obvious) over Fell '501 in view of Fell et al. U.S. Patent No. 6,206,927 ("Fell '927".) The Examiner relied on Fell '927 allegedly teaching positive slope of the superior surface relative to the inferior surface, in making the rejection. Lastly, claim 18 was rejected under 35 U.S.C. §103(a) as unpatentable (obvious) over Fell '501 in view of Repicci U.S. Patent Publication No. 2002/0133230 ("Repicci".) The Examiner relied on Repicci allegedly teaching a chamfer cut in the femoral condyle, in making the rejection. Applicants will address these various rejections as a group without needing to discuss each of the secondary references in detail, since all of the combinations of references in the various rejections suffer from the failings of the same primary reference, Fell '501.

Applicants traverse in view of the amendments made herein; the presently claimed invention is drawn to a device for implantation on a femoral condyle (wherein Fell '501's interpositional devices are not), and having, *inter alia*, a bone-facing implant surface opposing at least a portion of the femoral condyle and the trochlea (which feature Fell '501's interpositional devices are completely devoid of.) One of ordinary skill in the art would, it is respectfully submitted, simply not find any teachings in Fell '501 pertinent in devising an implant for a femoral condyle, much less combining the '501 teachings with the various secondary references cited by the Examiner in that endeavor. The teaching of the primary Fell '501 reference is therefore insufficient to render the claimed invention obvious to one of ordinary skill in the art, alone, or in combination with the references noted above. As such, Applicants respectfully

submit that the claimed invention is not obvious as urged by the Examiner, and request withdrawal of the rejection.

CONCLUSION

It is believed that the application is in condition for allowance. Consideration of the application and issuance of a notice of allowance are respectfully requested.

Applicants request that the undersigned, Alexander J. Smolenski, Jr., be contacted if it will assist further examination of this application.

Respectfully submitted,

/Alexander J. Smolenski, Jr., #47,953/

Alexander J. Smolenski, Jr.
Registration No. 47,953
Attorneys for Applicants

Bromberg & Sunstein LLP
125 Summer Street
Boston, MA 02110-1618
(617) 443-9292
02960/00118 831866.1